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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,678	03/03/2004	Matthew Rubin Lerner	003797.00912	2303
28319 7590 04/03/2007 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER VAUGHN, GREGORY J	
			ART UNIT 2178	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/03/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/790,678	Applicant(s) LERNER ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7,8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Action Background*

1. This action is responsive to the Request for Continued Examination, filed on 1/31/2007.
2. Applicant has canceled claims 3, 6, 9 and 12, and amended claims 1, 2, 4, 7, 8 and 10.
3. Claims 1, 2, 4, 5, 7, 8, 10 and 11 are pending in the case, claims 1 and 7 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 10/31/2006) has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/2007 has been entered.
5. Examiner's rejection of claim 1, 6, 7 and 12, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 10/31/2006) is withdrawn in view of the canceled or amended claims.
6. Examiner's rejection of claim 5 and 11, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 10/31/2006) is withdrawn in view of the applicant's remarks.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*

8. Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

9. **Regarding claims 1 and 7**, the amendment filed 1/9/2007 adds the following limitation: *"wherein the attributes are not user-definable"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."*

11. Claims 1, 2, 4, 5, 7, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Golovchinsky et al. US Patent 6,389,435, filed 2/5/1999, patented 5/14/2002 (hereinafter Golovchinsky).

12. **Regarding independent claim 1**, Golovchinsky discloses a plurality of annotated documents, where the annotated documents are web-based documents with annotation data. Golovchinsky discloses web-based documents as hypertext documents (see column 1, lines 15-40) used on the Internet (column 3, lines 31-39). Golovchinsky discloses annotation data as digital ink in Figures 2 and 3 (shown at reference signs 42, 44 and 46).

Golovchinsky discloses a searching an index of annotation data attributes to obtain a set of documents that is a subset of the plurality of annotated documents. Golovchinsky recites: *"this invention is directed to an electronic system that facilitates navigation from an index to portions of a document or documents that are of interest to the user"* (column 1, lines 7-11) and *"by making a variety of different types and styles of freeform digital ink marks in*

*the index, the relationships between terms in a document can be more quickly comprehended by a user"* (column 2, lines 16-19).

Golovchinsky discloses generating a thumbnail of the annotated document in figure 4. Golovchinsky discloses associating searchable attributes to the annotation data with a searchable index. Golovchinsky recites: "*this invention facilitates navigation from an index to portions of a document that are of interest to a user using freeform digital ink. A user can mark terms in an index page using freeform digital ink and the freeform digital ink mark is copied to instances of the annotated terms that occur in the document*" (column 1, line 67 to column 2, line 5). Golovchinsky discloses searching the plurality of annotated documents for a subset of the annotated documents. Golovchinsky recites: "*An embodiment of the system and method of this invention treats the selection of multiple original freeform digital ink marks as a query that causes the system to display a ranked list of search results*" (column 4, lines 27-31).

13. **Regarding dependent claim 2**, Golovchinsky discloses the attributes include at least an author of the annotated document. Golovchinsky disclose the document as a Microsoft Word document in Figure 3, reference sign 50. As is well known in the art, a Microsoft Word document file includes various attributes, including the author of the document.

14. **Regarding dependent claim 4**, Golovchinsky discloses the attributes include a website associated with the annotated document. Golovchinsky discloses the documents as a web-based document in Figure 3, reference

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sign 50 (shown as "hypertext.doc") and that the documents can be a collection of documents (column 1, lines 38-40), and that are part of the Internet (column 3, lines 37-40).

15. **Regarding dependent claim 5**, Golovchinsky discloses set of annotated documents includes at least two documents. Golovchinsky recites: *"this invention is directed to an electronic system that facilitates navigation from an index to portions of a document or documents"* (column 1, lines 7-11).
16. **Regarding claims 7, 8, 10 and 11**, the claims are directed toward a computer readable media for the method of claims 1, 2, 4 and 5, respectively, and are rejected using the same rationale.

***Response to Arguments***

17. Applicant's arguments filed 1/9/2007 have been fully considered but they are not persuasive.
18. Regarding the rejections made under 35 USC 112, applicant has remedied the deficiencies noted by the examiner in the office action dated 10/31/2006, however, the amendment filed 1/9/2007 raises new issues under 35 USC 112, as noted above.
19. Regarding independent claims 1 and 7, applicant argues that Golovchinsky fails to teach or suggest that the attributes are not user definable (page 6, first paragraph, of the response filed 1/9/2007). The examiner has reviewed the originally filed specification and has failed to determine the difference between attributes, and attributes that are not user definable. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.



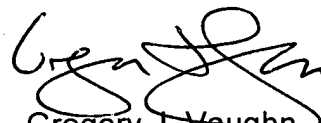
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***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory J. Vaughn  
Patent Examiner  
March 30, 2007